



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/182,499	10/30/98	HEYSE	G

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MM42/0803

EXAMINER

GHATT, D

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 08/03/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/182,499

Applicant(s)
Heyse et al.

Examiner
Dave Ghatt

Group Art Unit
2854



☒ Responsive to communication(s) filed on Oct 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-49 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 24-49 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 24-47, drawn to a tape cassette for accommodating a supply of printable tape, classified in class 400, subclass 208.
 - II. Claim 48, drawn to a tape spool, classified in class 400, subclass 242.
 - III. Claim 49, drawn to a tape spool in combination with image receiving tape which has a releasable backing layer, classified in class 400, subclass 237.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I is related to a ribbon *package* that is to be attached to a printing machine and is classified in class 400/208. The invention of group II is related to subject matter wherein a ribbon in the form of an elongated tape is spirally wound around a cylindrical member, and wherein significance is attributed to said member or to holding the member and the ribbon wound thereon. The invention of Group II is therefore not required by a ribbon *package*. The invention of group II is

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classified in class 400/242. The subcombination has separate utility such as a bobbin for holding thread on a sewing machine, or for use as a bobbin for holding electrical wires.

3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I is related to a ribbon *package* that is to be attached to a printing machine and is classified in class 400/208. The invention of group III is related to subject matter wherein a ribbon in the form of an elongated tape is spirally wound around a cylindrical member, and wherein significance is attributed to said member or to holding the member and the ribbon wound thereon. The invention of Group III is therefore not required by a ribbon *package*. The invention of group III the actual ribbon itself with a releasable backing with specified relations between the width of the tape and the width of the releasable layer and this aspect of the invention is classified in class 400/ 237 and class 428/195. The subcombination has separate utility such as s bobbin for dispensing adhesive tape material.

4. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately

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usable. In the instant case, invention III, the ribbon spool in combination with image receiving tape which has a releasable backing layer, has separate utility such as in adhesive tape dispensers. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. A telephone call was made to Felix D'Ambrosio on July 28 1999, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Ghatt whose telephone number is (703) 308-3698. The examiner can normally be reached on Monday to Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edgar Burr, can be reached on (703) 308-0979. The fax number for this Group is (703) 308-5841.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.



Dave Ghatt

August 2, 1999



**REN YAN
PRIMARY EXAMINER**